REMARKS

This responds to the Office Action mailed on October 15, 2008. Reconsideration and continued examination is respectfully requested in view of the following remarks.

Status of Claims

Claims 27-32 are pending in the instant application. In particular, claims 27-32 have been rejected based on prior art, while claims 1-12 were previously cancelled and claims 13-26 were withdrawn from consideration in view of the Examiner's restriction requirement. Finally, new claims 33-39 have been added to the instant application.

Request For Continued Examination

The Applicant has filed concurrently herewith a Request for Continued Examination under 37 CFR §1.114 in order to continue examination of the instant application.

§101 Rejection of the Claims

The Examiner has maintained his rejection of claims 27-32 under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. In particular, the Examiner states that the Applicant claims a "system for converting interactive Internet content" and that this system comprises a plurality of means and data structures for storing data. However, the Examiner contends that neither the means nor the data structures provide hardware components comprising a system. As such, the Examiner concludes that the claimed system appears to be a software system comprising functional descriptive material and is therefore directed toward non-statutory subject matter.

The United States Court of Appeals for the Federal Circuit clarified the standards applicable to determining whether a claimed method constitutes a "statutory process" in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). The Federal Circuit held that the machine-or-transformation test is the proper test to apply. The machine-or-transformation test is a two-branched inquiry. The applicant may show that a process claim satisfies §101 either by showing that a claim is tied to a particular machine, or by showing that the claim transforms an article.

The present application discloses that "[p]rocessor 131 runs the programs in accordance with various aspects of the present invention. Processor 131 interfaces with network connections

via Network Interface 132. Data and programs may be stored and accessed by Processor 131 from Disk 137, which may be, but is not limited to, a single disk, multiple disks, RAID disk subsystems, solid-state disks, tapes, DVDs, even network servers, clusters and data carousels." (*See* Application, paragraph 0028.) Independent claim 27, as amended, now recites in part "a *storage media* comprising program code and a plurality of data structures" and a "*processor* to execute the program code to enable the system to select and partition one or more pages of the interactive Internet content into a plurality of partitions, to integrate data stored in the Page URL, Page Partition, and Partition Link data structures and partitions into a bundle, and to distribute the bundle to a client device." (Emphasis Added). Applicant submits that amended independent claim 27 at least satisfies the first branch of the machine-or-transformation test since the system claims a processor and storage media for effectuating the system, and, thus, complies with 35 USC §101. Based on the foregoing, Applicant asserts that all of the claims, as amended, recite statutory subject matter under 35 USC §101 since the claim elements are tied to either a processor and/or storage device. Therefore, reconsideration and withdrawal of the §101 rejections is respectfully requested.

§103 Rejection of the Claims

Claims 27-29 and 31-32 remain rejected under 35 USC 103(a) as being unpatentable over Kim et al. (U.S. Patent No. 7,356,530) in view of Holland et al. (U.S. Patent No. 6,507,867), while claim 30 remains rejected as being unpatentable over Kim and Holland and in further view of Jeffrey. The Applicant respectfully traverses the above rejections.

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City,* 383 U. S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.[1]

[1] *See* Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1336-37 (Fed. Cir. 2005).

Therefore, the test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention.[2] The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 USC § 103 recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art.[3] The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art.[4] When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.[5] Additionally, critical differences in the prior art must be recognized (when attempting to combine references).[6]

Moreover, the Examiner must avoid hindsight.[7] That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention.[8] The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.[9]

With respect to independent claim 27, the Examiner asserts that Kim discloses "a system for converting interactive Internet content to a form suitable for distribution to clients with a limited or non-existent return channel while preserving the interactivity of the content, the system comprising: means for selecting and partitioning one or more pages of interactive content"...a Page URL data structure storing data for use in identifying pages of interactive content...a Page Partition data structure storing data for use in tracking partitions that make up a page of interactive content...a Partition Link data structure storing data for use in tracking navigation data contained in a partition."

Although the Examiner admits that Kim fails to specifically disclose a "means for integrating data stored in the Page URL, Page Partition, and Partition Link data structures and partitions into a bundle; and means for distributing the bundle to a client device, the Examiner

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[2] *See* Interconnect Planning Corp. V. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed.Cir.1985).
[3] *See* In re Bond, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS.
[4] *See* Stranco Inc. v. Atlantes Chemical Systems, Inc., 15 U.S.P.Q.2d 1704, 1713 (Tex. 1990).
[5] Id. p. 4 citing United States v. Adams, 383 U.S. 39, 51-51 (1966).
[6] *See* In re Bond, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS.
[7] M.P.E.P. § 2143.01 (citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).
[8] *See* In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).
[9] *See* In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

contends that Holland discloses "means for integrating data stored in the Page URL, Page Partition, and Partition Link data structures and partitions into a bundle...means for distributing the bundle to a client device." The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine Holland with Kim since it would have allowed for efficient transfer of page components into a single packet.

Independent claim 27 as amended recites a "system for converting interactive Internet content to a form suitable for distribution to clients with a limited or non-existent return channel while preserving the interactivity of the content, the system comprising a storage media including program code and a plurality of data structures, the plurality of data structures comprising a Page URL Uniform Resource Locator ("URL") data structure storing data for use in identifying pages of interactive Internet content; a Page Partition data structure storing data for use in tracking partitions that make up a page of interactive Internet content; and a Partition Link data structure storing data for use in tracking navigation data contained in a particular partition of a plurality of partitions; and a processor to execute the program code to enable the system to select and partition one or more pages of the interactive Internet content into the plurality of partitions, to integrate data stored in the Page URL, Page Partition, and Partition Link data structures and partitions into a bundle. and to distribute the bundle to a client device."

In contrast, neither Kim nor Holland teach or suggest the claim limitation of a processor to execute the program code to enable the system to select and partition one or more pages of the interactive Internet content into ***the plurality of partitions*** as presently recited in independent claim 27. The Examiner states that Kim teaches "partitioning of web pages" and that "each crawled page is partitioned from every other crawled page."[10] Accordingly, Kim fails to teach or suggest partitioning a page into a plurality of partitions since the reference can only partition a particular page into a single partition and not a plurality of partitions as presently claimed by the Applicant. Similarly, Holland also fails to teach or suggest partitioning a page into a plurality of partitions.

Moreover, neither Kim nor Holland, alone or in combination teach or suggest a processor to integrate data stored in the Page URL, Page Partition, and Partition Link data structures and partitions into a bundle since neither reference, as noted above, discloses partitioning a page into a plurality of pages as presently recited in independent claim 27.

[10] *See* Office Action, page 8.

Based on the foregoing, a prima facie case of obviousness cannot be established by the Examiner since the cited art does not teach or suggest every claim element of independent claim 27. Accordingly, the Examiner is respectfully requested to withdraw his rejection of independent claim 27 and indicate the allowance thereof. In addition, the Examiner is respectfully requested to withdraw the rejections of dependent claims 28-32 by virtue of their respective dependencies from independent claim 27 and indicate the allowance thereof.

The remarks made above with respect to independent claim 27 and the disclosures of Kim and Holland similarly apply to new independent claim 34. With respect to claim 34, Kim and Holland do not teach or suggest processing each of the one or more pages of interactive Internet content at the processor to select and partition one or more pages into the plurality of partitions. The cited references also do not teach or suggest processing each of the one or more pages of interactive Internet content at the processor to integrate data stored in the Page URL, Page Partition, and Partition Link data structures and partitions into a bundle and to distribute the bundle to a client device.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (314) 552-6855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-1662.

Respectfully submitted,

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